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PATENT  
Attorney Docket No. 014643-012110US/  
A-72018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

In re application of:

TOMIZUKA, et al

Serial No.: 10/000,433

Filing Date: November 30, 2001

For: *Transgenic Transchromosomal Rodents  
For Making Human Antibodies*

Examiner: Li, Q. Janice

Art Unit: 1632

APR 01 2003

TECH CENTER 1600/2900

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on:

Dated: March 24, 2003

Signed:

Lisa Jeanetta

RESPONSE TO OFFICE ACTION

Commissioner for Patents  
Washington, DC 20231

This is in response to the Office Action mailed February 24, 2003. This response is being filed on or before the deadline of March 24, 2003. Applicant believes no fees are due. However, the Commissioner is authorized to charge additional fees which may be required, including extension fees, or credit any overpayment, to Deposit Account No. 50-2319 (Our Order No. 455675-83).

**Response to the Restriction Requirement**

In response to the Restriction Requirement, Applicant elects for further prosecution Group I, namely claims 1-11, drawn to a transgenic non-human mammal comprising two human immunoglobulin loci. Applicant further elects species 1, drawn to a transgenic non-human mammal comprising two human immunoglobulin loci, wherein the heavy chain locus is of a transchromosome and the light chain locus is associated with an endogenous chromosome.

Applicant traverses the restriction requirement with respect to the restriction between Group I and Group II. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04,

§ 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). MPEP 803.

Applicant respectfully asserts that there would be no serious burden on the Examiner to examine the claims of Group I and Group II together. The claims of Group II overlap almost entirely with the claims of Group I and as such would require similar search parameters. Specifically, Group II claims the transgenic mammal of Group I with the additional element of a specific mutation in the genome of the transgenic mammal. The additional element is presented in dependent form, depending from Group I claims.-

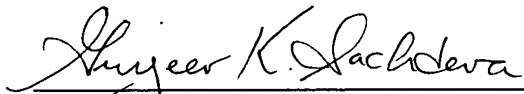
Furthermore, both Groups are classified in Class 800, subclass 23. Applicant contends the burden on the Examiner to search the claims of both Group I and Group II would be minimal compared to the burden placed on the Applicant if the Applicant must pursue these claims in separate applications.

Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,

DORSEY & WHITNEY LLP

Date March 24, 2003

  
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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application No.	10/000,433
		Filing Date	November 30, 2001
		First Named Inventor	Tomizuka \
		Examiner Name	Q. Janice Li
		Group Art Unit	1632
Total Number of Pages in This Submission	3	Attorney Docket No.	014643-012110US/ A-72018

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Response to Office Action	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Revocation of Previous Powers of Attorney and Appointment of New Power of Attorney	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Return Receipt Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	<input type="checkbox"/>
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, No. of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees, including extension fees, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 455675-83)	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		RECEIVED
Firm or Individual name	Gurjeev K. Sachdeva	APR 01 2003
Signature	<i>Gurjeev K. Sachdeva</i>	TECH CENTER 1600/2900
Date	March 24, 2003	

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with Sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, Washington, DC 20231 on this date: March 24, 2003	
Typed or printed name	Lisa Jeanetta
Signature	<i>Lisa Jeanetta</i>